

ESTTA Tracking number: **ESTTA709778**Filing date: **11/20/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Diamond Hong, Inc. & H&C Trading Co. Inc.		
Entity	Corporation	Citizenship	New York
Address	211-239 41 Street Brooklyn, NY 11232 UNITED STATES		

Attorney information	(Kenneth) Cang Li Law Offices of (Kenneth) Cang Li 1745 Broadway, 17th Floor New York, NY 10019 UNITED STATES kennethcli@hotmail.com Phone:212-362-6482
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Registration Subject to Cancellation

Registration No	4114136	Registration date	03/20/2012
Registrant	Cai, Zheng 352 S Barnswallow Lane Vernon Hills, IL 60061 UNITED STATES		

Goods/Services Subject to Cancellation


Class 030. First Use: 2005/06/08 First Use In Commerce: 2010/06/01 All goods and services in the class are cancelled, namely: Green tea; Tea; Tea bags


Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3966518	Application Date	08/08/2008
Registration Date	05/24/2011	Foreign Priority Date	NONE
Word Mark	TAI CHI		

Design Mark			
Description of Mark	<p>The mark consists of a man engaged in tai chi position atop a yin-yang symbol with the term "TAI CHI" below the symbol and a Chinese character on each side of the symbol.</p>		
Goods/Services	<p>Class 003. First use: First Use: 2010/01/03 First Use In Commerce: 2010/02/20 Cosmetics; skin care preparations, namely, body balm; body oils and essential oils</p> <p>Class 005. First use: First Use: 1999/10/08 First Use In Commerce: 1999/10/08 Dietary supplements; medicinal herbal extracts; sticking plasters for medical purposes; herbal topical creams, gels, powder, liniment and ointments for the relief of aches and pain; anti-inflammatory ointments; ginseng for medical use</p> <p>Class 029. First use: First Use: 2010/10/02 First Use In Commerce: 2010/10/02 Edible bird's nest; canned or bottled fruits; processed ginseng for use as a vegetable; processed vegetables; fish; seafood; and processed fruits</p> <p>Class 030. First use: First Use: 1999/10/08 First Use In Commerce: 1999/10/08 Processed herbs; processed ginseng used as an herb; herbal food beverages; royal jelly for food purpose; and tea</p> <p>Class 033. First use: First Use: 2010/11/08 First Use In Commerce: 2010/11/08 Wine; distilled spirits; and liqueurs</p>		
U.S. Registration No.	2449580	Application Date	05/29/1998
Registration Date	05/08/2001	Foreign Priority Date	NONE
Word Mark	TAI CHI		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 005. First use: First Use: 1999/10/08 First Use In Commerce: 1999/10/08 HERBAL FOOD SUPPLEMENTS; AND FOOD SUPPLEMENTS CONSISTING OF GINSENG AND/OR ROYAL JELLY, NAMELY, GINSENG EXTRACTUM AND GINSENG ROYAL JELLY</p> <p>Class 030. First use: First Use: 1999/10/08 First Use In Commerce: 1999/10/08 HERBAL TEAS; HERBAL FOOD BEVERAGES</p>
Attachments	<p>76691951#TMSN.png(bytes)</p> <p>75493319#TMSN.png(bytes)</p> <p>taichivstaichicancellationpetition.pdf(1640984 bytes)</p>

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/kcl/
Name	(Kenneth) Cang Li
Date	11/20/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DIAMOND HONG, INC.)	
& H & C TRADING CO. INC.)	
Petitioner,)	MARK: TAI CHI GREEN TEA
)	& A YIN-YANG SYMBOL
)	Reg. No. 4,114,136
)	Reg. date: March 20, 2012
v.)	Cancellation No.
)	
CAI, ZHENG DBA TAI CHI GREEN)	
TEA INC.)	
)	
Registrant)	

PETITION TO CANCEL

DIAMOND HONG, INC. and H & C TRADING CO. INC. ("Petitioner"), are New York corporations, with an office located at 211-239 41 Street, Brooklyn, NY 11232 believes that they will be damaged by registration of the mark composed of the English wording TAI CHI Green Tea and a Yin-Yang Symbol registration No. 4,114,136.

The grounds for cancellation are 1). Registrant's Registration No. 4114136 will cause likelihood of confusion with the petitioner's prior registered marks U.S. Registration Nos. 2,449,580 and 3,966,518 under Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* and 2). Registrant's aforesaid registration was obtained fraudulently via deceptive and misleading translation in its application.

1. Petitioner, by itself and through its predecessors, licensees, and related companies (collectively referred to hereinafter as "Petitioner"), have for many years been engaged, in interstate commerce, in the business of distributing, advertising and selling a line of health care goods including tea products.

2. Since at least as early as in October 1999, and long prior to the date of Registrant's self-claimed first use date in June 2010 (see Exhibit A - USPTO screenshots of registrant's registration certificate No. 4114136), Petitioner adopted and has continuously used the mark TAI CHI, its Chinese equivalent 太極 and a Yin-Yang Symbol shown hereunder covering tea products, among others.

3. Petitioner is the owner of two of federal trademark registrations for the wording TAI CHI, its Chinese equivalent 太極 and a Yin-Yang symbol in connection with health care goods, including teas:

- TAI CHI & A YIN-YANG SYMBOL U.S. Reg. No. 2,449,580
- TAI CHI, ITS CHINESE EQUIVALENT 太極 and a YIN-YANG SYMBOL U.S. Reg. No. 3,966,518 (See Exhibit B – USPTO screenshots for petitioner's two registrations).

The afore-cited registrations are subsisting, unrevoked and uncanceled, and have obtained incontestable status. Petitioner owns these cited marks shown therein and the goodwill connected therewith. In addition, Petitioner is the owner or registrant of a number of foreign trademark registrations or applications for TAI CHI, its Chinese equivalent 太極 and a Yin-Yang symbol marks for tea goods.

4. Since its adoption, Petitioner's mark composed of TAI CHI, its Chinese equivalent 太極 and a Yin-Yang symbol has been conspicuously applied to Petitioner's products. Said products so marked, promoted and advertised have been widely shipped, distributed and sold in interstate commerce throughout the United States and elsewhere. By virtue of the widespread sales, advertising and promotion of Petitioner's goods under the Petitioner's mark and the choice quality of the goods themselves, Petitioner's TAI CHI, its Chinese equivalent 太極 and a Yin-Yang symbol mark is recognized and relied upon as identifying Petitioner's goods and as distinguishing them from the goods of others, and has come to represent and symbolize a valuable goodwill and business belonging exclusively to Petitioner.

5. Below is a side by side comparison of the mark being petitioned to be cancelled by the registrant and those of the petitioner (the top two are Petitioner's marks and the bottom one is Registrant's) :



6. Petitioner's mark consists of a man engaged in a tai chi (Chinese martial arts) position atop a Yin-Yang symbol with the wording "Tai Chi" below the symbol and the Chinese equivalent characters 太極 on each side of the symbol. Similar to petitioner's mark, registrant's mark consists of a Yin-Yang symbol and the English wording Tai Chi Green Tea on top of the symbol and the words Wu Dang meaning a form of martial arts beneath it. The dominant and conspicuous portion and feature of both of the marks are a Yin-Yang Symbol and TAI CHI wording.

7. Due to the identical wording and design of Registrant's mark to Petitioner's marks, and the identical nature of the tea goods offered under the marks, and to the extensive reputation of Petitioner's mark composed of English wording Tai Chi, its Chinese equivalent characters 太極 and a Yin-Yang symbol, concurrent use of the mark TAI CHI, and a Yin-Yang Symbol by Registrant and Petitioner both for the tea products would not only likely, but also definitely result in consumer confusion as to source, sponsorship, approval, or affiliation within the meaning of 15 U.S.C. § 1114 and 1125(a), and, therefore, Petitioner is likely to be damaged by registration of Registrant's registered mark within the meaning of 15 U.S.C. § 1063(a). In addition, the examining attorneys must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). TMEP §§ 1207.01(d)(i).

8. As is known to all, the words TAI CHI mean a form of martial arts, namely, "a Chinese form of exercise that uses very slow and controlled movements" (see Exhibit C – Screenshots of excerpts of Merriam-Webster Dictionary). However, to confuse the public and the examiner, in the English translation of registrant's trademark application, registrant concealed the real meaning of the wording Tai Chi as a form of martial arts so as to circumvent the petitioner's mark showing a man engaged in a Tai Chi (martial arts) position on top of a Yin-Yang Symbol. Such translation is not only deceptive, misleading, but also fraudulent.


WHEREFORE, Petitioner prays that Petitioner's petition be granted and registrant's registration No. 4,114,136 be cancelled.

POWER OF ATTORNEY

Petitioner hereby appoints (KENNETH) CANG LI OF LAW OFFICES OF (KENNETH) CANG LI, 1745 Broadway, 17TH Floor, New York, N.Y. 10019, its attorneys, to prosecute this opposition proceeding and to transact all business before the United States Patent Office and Trademark Office in connection therewith.

Respectfully submitted,

For Diamond Hong, Inc. & H & C
Trading Co., Inc.

By: 
(Kenneth) Cang Li
Attorneys for Petitioner
1745 Broadway, 17th Floor
New York, New York 10019
Tel: (212) 362-6482
Fax: (347) 426-0473
E-mail: Kennethcli@hotmail.com

Dated: Nov. 19, 2015
Atty Docket No. : DH-015-11

Exhibits: 1). Exhibit A - USPTO screenshots of registrant's registration No. 4114136;
2). Exhibit B – USPTO screenshots for petitioner's registration Nos. 2449580
and 3966518;
3). Exhibit C - Screenshots of excerpts of Merriam-Webster Dictionary.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing PETITION TO CANCEL was served on:

Cai, Zheng, DBA Tai Chi Green Tea Inc.
352 S Barnswallow Lane
Vernon Hills, IL 60061

By placing same with the U.S. Postal Service, via first class mail, postage pre-paid, this 20th
Day of November, 2015

CERTIFICATE OF ELECTRONIC SERVICE

It is hereby certified that the foregoing PETITION TO CANCEL was served electronically at <http://esta.uspto.gov> on this 20 day of November, 2015.

By: 

Name: CANG L2
(PRINT OUT)

Exhibit A

United States of America

United States Patent and Trademark Office



Wu Dang

Reg. No. 4,114,136

Registered Mar. 20, 2012

Int. Cl.: 30

TRADEMARK

PRINCIPAL REGISTER

CAI, ZHENG (UNITED STATES INDIVIDUAL), DBA TAI CHI GREEN TEA INC
352 S BARNSWALLOW LANE
VERNON HILLS, IL 60061

FOR: GREEN TEA; TEA; TEA BAGS, IN CLASS 30 (U.S. CL. 46).

FIRST USE 6-8-2005; IN COMMERCE 6-1-2010.

OWNER OF U.S. REG. NOS. 3,921,201 AND 3,958,979.

THE COLOR(S) GREEN AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TAI CHI GREEN TEA", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF A CIRCLE OUTLINED IN GREEN, THAT DIVIDES TO BE HALF GREEN AND HALF WHITE, WITH A SINGLE DOT LOCATED AT EACH HALF WITH THE OPPOSITE COLOR; ON THE TOP OF THE MARK, IT HAS WORDS "TAI CHI GREEN TEA"; AT THE BOTTOM OF THE MARK, IT HAS WORDS "WU DANG".

THE ENGLISH TRANSLATION OF "TAI CHI" IN THE MARK IS EXTREMELY SUPERIOR.

SER. NO. 85-327,448, FILED 5-23-2011.

SHAUNIA CARLYLE, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

Exhibit B

Int. Cls.: 5 and 30

Prior U.S. Cls.: 6, 18, 44, 46, 51, and 52

United States Patent and Trademark Office

Reg. No. 2,449,580

Registered May 8, 2001

**TRADEMARK
PRINCIPAL REGISTER**



**H & C TRADING CO. INC. (NEW YORK CORPORATION)
125 15TH STREET
BROOKLYN, NY 11215**

**FOR: HERBAL FOOD SUPPLEMENTS; AND
FOOD SUPPLEMENTS CONSISTING OF GINSENG
AND/OR ROYAL JELLY, NAMELY, GINSENG EX-
TRACTUM AND GINSENG ROYAL JELLY, IN
CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).**

FIRST USE 10-8-1999; IN COMMERCE 10-8-1999.

**FOR: HERBAL TEAS; HERBAL FOOD BEVERA-
GES, IN CLASS 30 (U.S. CL. 46).**

FIRST USE 10-8-1999; IN COMMERCE 10-8-1999.

SN 75-493,319, FILED 5-29-1998.

LINDA M. KING, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office



Reg. No. 3,966,518

Registered May 24, 2011

Int. Cls.: 3, 5, 29, 30, and 33

DIAMOND HONG, INC. (NEW YORK CORPORATION)
211-239 41 STREET
BROOKLYN, NY 11232

FOR: COSMETICS; SKIN CARE PREPARATIONS, NAMELY, BODY BALM; BODY OILS AND ESSENTIAL OILS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 1-3-2010; IN COMMERCE 2-20-2010.

TRADEMARK

PRINCIPAL REGISTER

FOR: DIETARY SUPPLEMENTS; MEDICINAL HERBAL EXTRACTS; STICKING PLASTERS FOR MEDICAL PURPOSES; HERBAL TOPICAL CREAMS, GELS, POWDER, LINIMENT AND OINTMENTS FOR THE RELIEF OF ACHES AND PAIN; ANTI-INFLAMMATORY OINTMENTS; GINSENG FOR MEDICAL USE, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 10-8-1999; IN COMMERCE 10-8-1999.

FOR: EDIBLE BIRD'S NEST; CANNED OR BOTTLED FRUITS; PROCESSED GINSENG FOR USE AS A VEGETABLE; PROCESSED VEGETABLES; FISH; SEAFOOD; AND PROCESSED FRUITS, IN CLASS 29 (U.S. CL. 46).

FIRST USE 10-2-2010; IN COMMERCE 10-2-2010.

FOR: PROCESSED HERBS; PROCESSED GINSENG USED AS AN HERB; HERBAL FOOD BEVERAGES; ROYAL JELLY FOR FOOD PURPOSE; AND TEA, IN CLASS 30 (U.S. CL. 46).

FIRST USE 10-8-1999; IN COMMERCE 10-8-1999.

FOR: WINE; DISTILLED SPIRITS; AND LIQUEURS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 11-8-2010; IN COMMERCE 11-8-2010.

THE MARK CONSISTS OF A MAN ENGAGED IN A TAI CHI POSITION ATOP A YIN-YANG SYMBOL WITH THE TERM "TAI CHI" BELOW THE SYMBOL AND A CHINESE CHARACTER ON EACH SIDE OF THE SYMBOL.

THE NON-LATIN CHARACTERS IN THE MARK TRANSLITERATE INTO "TAI CHI" OR TAI JI.



David J. Kappas

Director of the United States Patent and Trademark Office

Reg. No. 3,966,518 THE NON-LATIN CHARACTERS IN THE MARK TRANSLATE INTO ENGLISH AS "TAI CHI".

SN 76-691,951, FILED 8-8-2008.

ALEXANDER L. POWERS, EXAMINING ATTORNEY

Exhibit C



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tai chi



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tai chi

noun, often capitalized T&C | ˈtɪ-ˈjē, ˈtɪ-ˈchē\

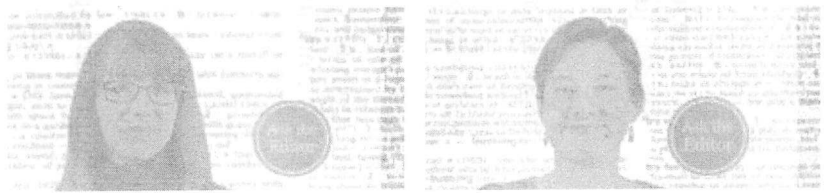
: a Chinese form of exercise that uses very slow and controlled movements

How we introduced the
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